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EXAMINER

STACE, BRENT S

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2161

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10/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/674,802

Applicant(s)

PAGE, LAWRENCE E.

Examiner

Brent S. Stace

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-24, 26-28, 30-40, 42, 43 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-24, 26-28, 30-40, 42, 43 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Remarks***

1. This communication is responsive to the amendment filed August 6<sup>th</sup>, 2007. Claims 1-3, 5-24, 26-28, 30-40, 42, 43, and 47-49 are pending. In the amendment filed August 6<sup>th</sup>, 2007, Claims 1, 21, 22, 43, and 47 are amended, Claim 41 is canceled, and Claims 1, 21, 22, 43, and 47 are independent. The examiner acknowledges that no new matter was introduced and the claims are supported by the specification. This action is made FINAL.

### ***Response to Arguments***

2. Applicant's arguments filed August 6<sup>th</sup>, 2007 with respect to Claims 1-3, 5-24, 26-28, 30-40, 42, 43, and 47-49 have been fully considered but they are not persuasive.
3. As to the applicant's arguments with respect to exemplary Claim 1 (including Claims 21 and 47) for the prior art(s) allegedly not teaching or suggesting "storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items," the examiner respectfully disagrees. Mao, col. 3, lines 55-58 was used to teach this limitation. In the cited section Mao teaches:

Once the document data, e.g. text and graphics, 103 is read by the index creation system 102, it is temporarily stored in a memory 108 to further process the document data 103 to create an index table therefrom.

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First, the index table in Mao, being a collection of data, appears to be the data sets.

These data sets, according to Mao's teaching, originate from printed documents, such as books (see also, Mao, col. 1, lines 24-29 and Mao, col. 2, lines 57-65). Second, magazines are books, and books, like magazines, are known to have advertisements printed therein. Mao can equally work with magazines as it can with books since the teaching of "books" clearly covers the subset of magazines under books.

Advertisements are an additional source of income for the entities involved in making the book/magazine/catalog/novel etc. Mao teaches that all of the document data is collected from the pages of the book ("text and graphics") (additionally, the Applicant agrees with this notion since the Applicant states, "...MAO discloses converting all data on a document to ASCII code and storing the data" at the bottom of page 19 in the remarks dated 8/6/07). Therefore, the advertisements printed with the book/magazine are also collected by the index creation system since the advertisements are considered to be document data (since the printed advertisements are a part of or contained in the printed document).

4. As to the applicant's arguments with respect to Claim 22 for the prior art(s) allegedly not teaching or suggesting "the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items and information representing an advertisement printed with the at least one of the

printed items," the examiner respectfully disagrees. Mao, col. 3, lines 55-58 was used to teach this limitation.

As for "the memory bank and the programmable computer node being adapted to store" Mao, Fig. 4 teaches multiple computers (PDA and PC) involved in the generally computer-driven system of Mao. Additionally, the citing in Mao includes hardware that either can be considered a computer in itself or requires connection to a computer (e.g. document reader). The information that the document reader acquires, according to the citing is stored. Storage of data requires a memory bank of some kind (e.g. at least memory 108 of Mao). As such, the citing appears to teach a "memory bank and the programmable computer node being adapted to store."

In the citing Mao further teaches that index tables are generated from the text and graphics from the hardcopy documents. Index tables are a searchable database (especially since Mao uses them for searching (Mao, col. 7, lines 1-5)). A table, by definition, includes datasets (a data set for each cell in the table). Therefore, Mao also appears to teach "the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set."

As shown above Mao teaches that the text and graphics are read in and stored from the printed documents (including the advertisements). As such, Mao teaches the "including text from at least one of the printed items and information representing an advertisement printed with the at least one of the printed items" limitation.

5. As to the applicant's arguments with respect to Claim 43 for the prior art(s) allegedly not teaching or suggesting "the data sets representing printed items include

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advertisements relating to the printed items, the advertisements including information for linking to information about a corresponding product, and wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items ,” the examiner respectfully disagrees.

The limitation of “wherein the data sets representing printed items include advertisements related to the printed items” has been met by Mao, col. 3, lines 55-58 as described above.

The limitation of “the advertisements including information for linking to information about a corresponding product” has been met by Smith, cols. 2-3, lines 59-5. In the cited section, Smith teaches that advertisements (for display on a monitor (Smith, col. 2, lines 6-8)) in a database can be modified. Information in the database regarding the advertisements is information such as a URL defining the content that appears when a consumer interacts with the ad that is displayed. This URL appears to be the claimed linking information. The database holds the advertisements and the advertisements in the database include information for linking to information (URL) about a corresponding product (like a sales promotion from Smith, col. 2, lines 6-8). As such, Smith appears to teach “the advertisements including information for linking to information about a corresponding product.” Even though Smith does not appear to teach printed items, the part of the claim argued that uses Smith claims data sets representing printed items, and advertisements related to the printed items.

Additionally, even though Smith may or may not have printed items, Mao was shown above to include advertisements with printed items.

The limitation of "wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items" has been met by Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21. In the cited sections, Mao teaches searching a document on a computer for search/query words and returning results. Mitchell teaches making an HTML (or SGML) page from document images (such as from scanned papers/books), making them available online, and Fig. 11 teaches search results that show the page and a segment of text where the search result is found. The segments of text in Mitchell, Fig. 11 appear to be the returned characterizations of the relevant publication items in the claim. Since, as mentioned above, when the document reader reads the printed materials, the advertisements get read in also. Mao's simple search technique will return results from advertisements also since the advertisements are included in the printed matter read into the system. As such when a search term is entered and matches something in an advertisement (just like printed matter), information (like characterizations) will be returned to the user from an advertisement since the advertisement is in at least one of the relevant printed items and since the advertisement is read in and searched equally to how other printed matter is read in and searched.

6. The other claims argued merely because of a dependency on a previously argued claim(s) or because they are substantially the same as a previously argued claim(s) in the arguments presented to the examiner, filed August 6<sup>th</sup>, 2007, are moot in view of the examiner's interpretation of the claims and art and are still considered rejected based on their respective rejections from a prior Office action (part(s) of recited again below).

***Response to Amendment***

***Specification***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

8. In light of the applicant's respective arguments or respective amendments, the previous 35 USC § 112 rejections to the claims have been withdrawn.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 8, 10, 13-17, 20, 21, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 5,963,966 (Mitchell) (Mao was cited in the PTO-892 form with the first office action).

For **Claim 1**, Mao teaches: "A computer-implemented method comprising:

- storing in a searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items, [Mao, col. 3, lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30]
- wherein storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items; [Mao, col. 3, lines 55-58]
- storing an index representing information included in a plurality of web documents; [Mao, col. 8, lines 12-18 with Mao, col. 4, lines 27-30]
- receiving a search query; [Mao, col. 7, lines 12-21]
- ...searching the data sets in the searchable database for data sets representing printed items, the search being based on the search query" [Mao, col. 7, lines 12-21 with Mao, Fig. 4].

Mao discloses the above limitations but does not expressly teach:

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- "...searching the index for web documents, the search being based on the search query;
- ...comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items; and
- for said at least one of the relevant printed items, providing an electronic reference for accessing further information."

With respect to Claim 1, an analogous art, Mitchell, teaches:

- "...searching the index for web documents, the search being based on the search query; [Mitchell, col. 9, lines 24-30 with Mitchell, cols. 13-14, lines 64-7]
- ...comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items; [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21] and
- for said at least one of the relevant printed items, providing an electronic reference for accessing further information" [Mitchell, col. 9, lines 14-16 with Mitchell, col. 9, lines 30-32]."

With respect to Claim 1, an analogous art, Google1, teaches:

- "...generating an integrated ranked listing" [Google1, page 1 with Google1, page 2, letter S].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell and Google1 with Mao because the inventions are directed towards searching documents.

Mitchell and Google1's inventions would have been expected to successfully work well with Mao's invention because the inventions use the internet for searching. Mao discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising results showing a ranked result listing. Mitchell discloses an automated capturing of technical documents for electronic review and distribution comprising converting hardcopy technical documents in to web pages, indexing and searching the HTML web pages, and displaying results of searches against the documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the creation of HTML documents from hard copy documents and the searching of those documents with the results returned from Mitchell and the ranked result listing from Google1 and install them into the invention of Mao, thereby offering the obvious advantage of finding web pages/printed documents associated with the documents found, accessing them, the user quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the document.

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**Claim 2** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, wherein the printed items, that are represented by stored data sets in the searchable database, are copyrighted printed items" [Mao, col. 1, lines 25-29 with Mao, col. 2, lines 51-56 with Mitchell, col. 5, lines 1-2].

**Claim 8** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, wherein returning at least one characterization of at least one of the relevant printed items includes returning information from a data set representing an advertisement for said at least one of the relevant printed items" [Mitchell, Fig. 11 with Mitchell, col. 9, lines 8-32].

**Claim 10** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, further including electronically scanning the printed items and generating scanned printed items, and wherein the stored data sets representing printed items in the searchable database includes data sets representing the scanned printed items" [Mitchell, col. 6, lines 33-44].

**Claim 13** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database" [Mitchell, col. 3, lines 54-61 with Mitchell, col. 1, lines 54-56].

**Claim 14** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, further including configuring the data set to display as a replica of the corresponding printed media" [Mitchell, col. 1, lines 54-56 with Mitchell, col. 7, lines 43-53].

**Claim 15** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database and wherein returning includes providing a hyperlink for an indexed entry with another representation of one of the printed items" [Google1, page 1 with Google1, Page 2, Q].

**Claim 16** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, wherein providing an electronic path for accessing further information includes providing at least one hyperlink that, when acted upon, links said at least one of the relevant printed items to a more complete electronic representation of the relevant printed items" [Google1, page 1 with Google1, Page 2, K, L, and O].

**Claim 17** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1, wherein providing an electronic reference for accessing further information includes providing at least one hyperlink that, when acted upon, links said at least one of the relevant printed items to an electronic representation of the relevant printed item, the electronic representation of the relevant printed item beginning as a continuation of information returned" [Google1, page 1 with Google1, Page 2, K, L, and O].

**Claim 20** can be mapped to Mao (as modified by Mitchell and Google1) as follows: "The method of claim 1 wherein the integrated ranked listing includes hyperlinks to respective electronic images of the relevant printed items and relevant web documents" [Mitchell, col. 7, lines 42-50 with Google1, page 1].

For **Claim 21**, Mao teaches: "A computer-implemented arrangement including a search engine and a searchable electronic database, [Mao, Fig. 4] the computer-implemented arrangement adapted to respond to Internet-based search queries, [Mao, col. 4, lines 24-34] comprising:

- means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items, [Mao, col. 3; lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30]
- wherein the means for storing data sets representing printed items includes means for storing data sets representing advertisements printed with the printed items; [Mao, col. 3, lines 55-58] and
- means, including the search engine, for responding to a search query [Mao, col. 7, lines 12-21 with Mao, Fig. 4] and including
- and searching the data sets in the electronic database for data sets, the search being based on the search query" [Mao, col. 7; lines 12-21 with Mao, Fig. 4].

Mao discloses the above limitations but does not expressly teach:

- "...means for searching for web pages, the search being based on the search query
- ...thereby identifying relevant web pages and relevant data sets corresponding to relevant publication items,
- means for returning at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant

publication items and, for said at least one of the relevant publication items, providing an electronic path for accessing further information; and

- means for ranking the returned at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant publication items to generate an integrated ranked listing of relevant characterizations."

With respect to Claim 21, an analogous art, Mitchell, teaches:

- "...means for searching for web pages, the search being based on the search query [Mitchell, col. 9, lines 24-30 with Mitchell, cols. 13-14, lines 64-7]
- thereby identifying relevant web pages and relevant data sets corresponding to relevant publication items, [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30]
- ...means for returning at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant publication items [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21] and, for said at least one of the relevant publication items, providing an electronic path for accessing further information; [Mitchell, col. 9, lines 14-16 with Mitchell, col. 9, lines 30-32] and
- ...the returned at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant publication items ... of relevant characterizations" [Mitchell, col. 7, lines 43-46 with Mitchell,

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cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30].

With respect to Claim 21, an analogous art, Google1, teaches:

- “means for ranking ...to generate an integrated ranked listing” [Google1, page 1 with Google1, page 2, letter S].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell and Google1 with Mao because the inventions are directed towards searching documents.

Mitchell and Google1's inventions would have been expected to successfully work well with Mao's invention because the inventions use the internet for searching. Mao discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising results showing a ranked result listing. Mitchell discloses an automated capturing of technical documents for electronic review and distribution comprising converting hardcopy technical documents in to web pages, indexing and searching the HTML web pages, and displaying results of searches against the documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the creation of HTML documents from hard copy documents and the searching of those documents with the results returned from Mitchell and the ranked



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result listing from Google1 and install them into the invention of Mao, thereby offering the obvious advantage of finding web pages/printed documents associated with the documents found, accessing them, the user quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the document.

For **Claim 47**, Mao teaches: "A machine-implemented method for searching one or more searchable electronic databases, [Mao, col. 7, lines 12-21 with Mao, Fig. 4] comprising:

- storing data sets representing publication items respectively produced by a plurality of respective publishers, [Mao, col. 3, lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30]
- wherein storing data sets representing publication items includes storing data sets representing advertisements printed with the printed items; [Mao, col. 3, lines 55-58]
- responsive to a search query, ... and searching the data sets in the electronic database for the data sets, the search being based on the search query..." [Mao, col. 7, lines 12-21 with Mao, Fig. 4].

Mao discloses the above limitations but does not expressly teach:

- "...electronically searching for web-accessible documents, the search being based on the search query...thereby identifying web-accessible documents and relevant data sets representing publication items;

- receiving a ranking the identified web-accessible documents and the relevant data sets representing publication items; and
- returning as search results a ranked listing including:
  - at least one characterization of at least one of the relevant web-accessible documents, or
  - at least one characterization of at least one of the relevant publication items
  - for said at least one of the relevant publication items, an electronic path for accessing further information.”

With respect to Claim 47, an analogous art, Mitchell, teaches:

- “...electronically searching for web-accessible documents, the search being based on the search query...thereby identifying web-accessible documents and relevant data sets representing publication items; [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30]
- the identified web-accessible documents and the relevant data sets representing publication items; [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30] and
- returning as search results [Mitchell, Fig. 11 including:
  - at least one characterization of at least one of the relevant web-accessible documents, [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21] or

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- at least one characterization of at least one of the relevant publication items [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21]
- for said at least one of the relevant publication items, an electronic path for accessing further information" [Mitchell, col. 9, lines 14-16 with Mitchell, col. 9, lines 30-32].

With respect to Claim 47, an analogous art, Google1, teaches:

- receiving a ranking [Google1, page 1 with Google1, page 2, letter S]
- a ranked listing" [Google1, page 1 with Google1, page 2, letter S].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell and Google1 with Mao because the inventions are directed towards searching documents.

Mitchell and Google1's inventions would have been expected to successfully work well with Mao's invention because the inventions use the internet for searching. Mao discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising results showing a ranked result listing. Mitchell discloses an automated capturing of technical documents for electronic review and distribution comprising converting hardcopy technical documents

in to web pages, indexing and searching the HTML web pages, and displaying results of searches against the documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the creation of HTML documents from hard copy documents and the searching of those documents with the results returned from Mitchell and the ranked result listing from Google1 and install them into the invention of Mao, thereby offering the obvious advantage of finding web pages/printed documents associated with the documents found, accessing them, the user quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the document.

11. Claims 3, 11, 12, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of "How to Interpret your Search Results" (Google1), in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

For **Claim 3**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 2, further including."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach: "executing a permission protocol in which the publisher provides authorization that permits the search engine to display more text from said at least one of the relevant printed items."

With respect to Claim 3, an analogous art, Baxter, teaches: "executing a permission protocol in which the publisher provides authorization that permits the search engine to display more text from said at least one of the relevant printed items" [Baxter, paragraphs [0037], [0041], [0141] and [0145]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use databases. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao (as modified by Mitchell and Google1) does not expressly disclose a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol used for the publisher.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of restricting people from viewing safeguarded material until it is authorized. This adds an obvious security feature.

For **Claim 11**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 10."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, the authorization being in response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items."

With respect to Claim 11, an analogous art, Baxter, teaches:

- "...wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145]] the authorization being in response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items [Baxter, paragraph [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use databases. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao (as modified by Mitchell and Google1) does not expressly disclose a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of restricting people from viewing safeguarded material until it is authorized. This adds an obvious security feature.

For **Claim 12**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 10."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits a search engine to display more text from said at least one of the relevant publication items, the authorization being in

response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic reference for accessing further information for said at least one of the relevant publication items.”

With respect to Claim 12, an analogous art, Baxter, teaches:

- “...wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits a search engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145]] the authorization being in response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic reference for accessing further information for said at least one of the relevant publication items” [Baxter, paragraphs [0080], [0143] and [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use databases. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao (as modified by Mitchell and Google1) does not expressly disclose a permission protocol is



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used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of restricting people from viewing safeguarded material until it is authorized. This adds an obvious security feature.

For **Claim 48**, Mao (as modified by Mitchell and Google1) teaches: "The machine-implemented method of claim 47."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "wherein the electronic path includes a path for accessing data made available according to a permission protocol."

With respect to Claim 48, an analogous art, Baxter, teaches:

- "wherein the electronic path includes a path for accessing data made available according to a permission protocol" [Baxter, paragraphs [0037], [0041], [0141] and [0145]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use databases. Mao (as modified by Mitchell and Google1) discloses an information management systems comprising searching for documents relevant to a query, however Mao (as modified by Mitchell and Google1) does not expressly disclose that the path is made available according to a permissions protocol. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of safeguarding files from non-authorized users so that non-authorized users are not given a path to access the document.

For **Claim 49**, Mao (as modified by Mitchell and Google1) teaches: "The machine-implemented method of claim 47."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "wherein the electronic path provides access to further information made available by a publisher of the further information."

With respect to Claim 49, an analogous art, Baxter, teaches:

- "wherein the electronic path provides access to further information made available by a publisher of the further information" [Baxter, paragraphs [0037], [0041], [0141] and [0145]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use databases. Mao (as modified by Mitchell and Google1) discloses an information management systems comprising searching for documents relevant to a query, however Mao (as modified by Mitchell and Google1) does not expressly disclose that the path provides access to further information made available by a publisher of the further information. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of safeguarding files from non-authorized users so that authorized users are given a path to access further information.

12. Claims 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of "How to Interpret your Search Results" (Google1), in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent No. 6,502,076 (Smith).

For **Claim 5**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 1."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein storing data sets representing the advertisements includes storing information for linking to information about a product represented in one of the advertisements."

With respect to Claim 5, an analogous art, Smith, teaches:

- "...wherein storing data sets representing the advertisements includes storing information for linking to information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Mao (as modified by Mitchell and Google1) because both inventions are directed towards displaying documents on the web.

Smith's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use computers to display documents. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising storing/indexing all document contents, however Mao (as modified by Mitchell and Google1) does not expressly disclose information linking to information about a product represented in the ads. Smith discloses a system and methods for

determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

For **Claim 6**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 1."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein storing data sets representing the advertisements includes storing information for displaying information about a product represented in one of the advertisements."

With respect to Claim 6, an analogous art, Smith, teaches:

- "...wherein storing data sets representing the advertisements includes storing information for displaying information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Mao (as modified by Mitchell and Google1) because both inventions are directed towards displaying documents on the web.

Smith's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use computers to display documents. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising storing/indexing all document contents, however Mao (as modified by Mitchell and Google1) does not expressly disclose storing information for displaying information about a product represented in the ads. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

For **Claim 7**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 1."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein storing data sets representing the advertisements includes storing information directing a search engine to update advertisement information for one of the relevant printed items."

With respect to Claim 7, an analogous art, Smith, teaches:

- "...wherein storing data sets representing the advertisements includes storing information directing a search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 11-12, lines 61-14].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Mao (as modified by Mitchell and Google1) because both inventions are directed towards displaying documents on the web.

Smith's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use computers to display documents. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising storing/indexing all document contents, however Mao (as modified by Mitchell and Google1) does not expressly disclose storing information directing a search engine to update advertisement information for a printed item. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information:

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

For **Claim 9**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 8."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach:

- "...wherein returning information from a data set representing an advertisement includes returning information representing at least one of: information for linking to information about a product represented in one of the advertisements, information for displaying information about a product represented in one of the advertisements, or information directing the search engine to update advertisement information for one of the relevant printed items."

With respect to Claim 9, an analogous art, Smith, teaches:

- "...wherein returning information from a data set representing an advertisement includes returning information representing at least one of: information for linking to information about a product represented in one of the advertisements, information for displaying information about a product represented in one of the advertisements, or information directing the search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 2-3, lines 59-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Mao (as modified by Mitchell and Google1) because both inventions are directed towards displaying documents on the web.



Smith's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use computers to display documents. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising storing/indexing all document contents, however Mao (as modified by Mitchell and Google1) does not expressly disclose information for linking to information about a product represented in the ads. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of "How to Interpret your Search Results" (Google1), in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent No. 5,832,212 (Cragun et al.).

For **Claim 18**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 1."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach: "further including blocking portions of the relevant printed items that are not authorized for distribution."

With respect to Claim 18, an analogous art, Cragun, teaches: "further including blocking portions of the relevant printed items that are not authorized for distribution" [Cragun, cols, 6-7, lines 54-17].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Cragun with Mao (as modified by Mitchell and Google1) because both inventions are directed towards displaying content on the internet.

Cragun's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions use web browsers. Mao (as modified by Mitchell and Google1) discloses a method and apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao (as modified by Mitchell and Google1) does not expressly disclose blocking out content not authorized to be viewed. Cragun discloses censoring browser method and apparatus for internet viewing comprising blocking out unauthorized content.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the blocking out unauthorized content from Cragun and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of gaining granular document security for portions of documents not to be viewed.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of "How to Interpret your Search Results" (Google1), in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of "Google Search Technology" (Google2).

For **Claim 19**, Mao (as modified by Mitchell and Google1) teaches: "The method of claim 1."

Mao (as modified by Mitchell and Google1) discloses the above limitation but does not expressly teach: "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant printed items."

With respect to Claim 19, an analogous art, Google2, teaches: "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant printed items" [Google2, Page 1, under Integrity].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google2 with Mao (as modified by Mitchell and Google1) because both inventions are directed towards searching for documents.

Google2's invention would have been expected to successfully work well with Mao (as modified by Mitchell and Google1)'s invention because both inventions return search results. Mao (as modified by Mitchell and Google1) discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao (as modified by Mitchell and Google1) does not expressly disclose embedding

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advertisements with the characterization(s). Google2 discloses search results comprising advertisements/ads.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the ads from Google2 and install it into the invention of Mao (as modified by Mitchell and Google1), thereby offering the obvious advantage of including more relevant results in the form of ads.

15. Claims 22, 23, 31, 34-38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell).

For **Claim 22**, Mao teaches: "A computer-implemented arrangement including a search engine and a searchable electronic database, [Mao, Fig. 4] the computer-implemented arrangement adapted to respond to Internet-based search queries, [Mao, col. 4, lines 24-34] comprising:

- a memory bank and a first programmable computer node, [Mao, Fig. 4] the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items [Mao, col. 3, lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30] and information representing an advertisement printed with the at least one of the printed items; [Mao, col. 3, lines 55-58] and

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- a second programmable computer node including the search engine, [Mao, col. 7, lines 12-21 with Mao, Fig. 4]...and to search the data sets in the electronic database for data sets, the search being based on the search query, [Mao, col. 7, lines 12-21 with Mao, Fig. 4]
- ...and, for said at least one of the relevant printed items, to provide the information representing an advertisement for said at least one of the relevant printed items" [Mao, col. 3, lines 55-58].

Mao discloses the above limitations but does not expressly teach:

- "...the second programmable computer node adapted to search for web pages, the search being based on a search query... thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant printed items, and
- to return at least one characterization of at least one of the relevant web pages and at least one characterization of at least of the relevant printed items."

With respect to Claim 22, an analogous art, Mitchell, teaches:

- "...the second programmable computer node adapted to search for web pages, the search being based on a search query [Mitchell, col. 9, lines 24-30 with Mitchell, cols. 13-14, lines 64-7]... thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant printed items, [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30] and
- to return at least one characterization of at least one of the relevant web pages and at least one characterization of at least of the relevant printed items"

[Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Mao because the inventions are directed towards searching documents.

Mitchell and Google1's inventions would have been expected to successfully work well with Mao's invention because the inventions use the internet for searching. Mao discloses a method an apparatus for indexing and searching content in hardcopy documents comprising scanning whole documents, OCRing them, and indexing them, however Mao does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising results showing a ranked result listing. Mitchell discloses an automated capturing of technical documents for electronic review and distribution comprising converting hardcopy technical documents in to web pages, indexing and searching the HTML web pages, and displaying results of searches against the documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the creation of HTML documents from hard copy documents and the searching of those documents with the results returned from Mitchell and the ranked result listing from Google1 and install them into the invention of Mao, thereby offering the obvious advantage of finding web pages/printed documents associated with the documents found, accessing them, the user quickly determining the relevance of the

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returned result(s), and showing most relevant results first and including a view to the document.

**Claim 23's** limitation(s) have already been met by Claim 2's limitation(s).

Therefore, Claim 23 is rejected for the same reason(s) as stated above with respect to Claim 2 (except as appropriate, the rejections would be Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

**Claim 31's** limitation(s) have already been met by Claim 10's limitation(s).

Therefore, Claim 31 is rejected for the same reason(s) as stated above with respect to Claim 10 (except as appropriate, the rejections would be Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

**Claims 34-38's** limitation(s) have already been met by Claims 13-17's limitation(s), respectfully. Therefore, Claims 34-38 are rejected for the same reason(s) as stated above with respect to Claims 13-17, respectfully (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

**Claim 42** can be mapped to Mao (as modified by Mitchell) as follows: "The arrangement of claim 22, further including an item-input arrangement including both a document scanner and a download path arranged to download an electronic version of at least one of the printed items, the item-input arrangement adapted to generate electronic versions of the printed items" [Mitchell, col. 7, lines 6-14].

16. Claims 26-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent No. 6,502,076 (Smith).

**Claims 26-28 and 30's** limitation(s) have already been met by Claims 5-7 and 9's limitation(s), respectfully. Therefore, Claims 26-28 and 30 are rejected for the same reason(s) as stated above with respect to Claims 5-7 and 9, respectfully (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

17. Claims 24, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

**Claim 24's** limitation(s) have already been met by Claim 3's limitation(s). Therefore, Claim 24 is rejected for the same reason(s) as stated above with respect to Claim 3 (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

**Claims 32 and 33's** limitation(s) have already been met by Claims 11 and 12's limitation(s), respectfully. Therefore, Claims 32 and 33 are rejected for the same reason(s) as stated above with respect to Claims 11 and 12, respectfully (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).



18. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of U.S. Patent No. 5,832,212 (Cragun et al.).

**Claim 39's** limitation(s) have already been met by Claim 18's limitation(s). Therefore, Claim 39 is rejected for the same reason(s) as stated above with respect to Claim 18 (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

19. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell), further in view of "Google Search Technology" (Google2).

**Claim 40's** limitation(s) have already been met by Claim 19's limitation(s). Therefore, Claim 40 is rejected for the same reason(s) as stated above with respect to Claim 19 (except as appropriate, the rejections would be based on Mao (as modified by Mitchell) as justified by the rejection on Claim 22).

20. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,385 (Mao) in view of U.S. Patent No. 5,963,966 (Mitchell), in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.), further in view of U.S. Patent No. 6,502,076 (Smith).

For **Claim 43**, Mao teaches: “An arrangement for maintaining an electronic database that is searchable via a search engine [Mao, Fig. 4] in response to Internet-based search queries, [Mao, col. 4, lines 24-34] the arrangement comprising:

- means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items [Mao, col. 3, lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30]
- wherein the data sets representing printed items include advertisements related to the printed items, [Mao, col. 3, lines 55-58]...
- with each stored data set representing printed items from publications [Mao, col. 3, lines 50-58 with Mao, Fig. 4, with Mao, col. 4, lines 27-30]...
- means, responsive to a search query and including the search engine, for [Mao, col. 7, lines 12-21 with Mao, Fig. 4] ... and searching the data sets in the electronic database for data sets, the search being based on the search query” [Mao, col. 7, lines 12-21 with Mao, Fig. 4].

Mao discloses the above limitations but does not expressly teach:

- “...the advertisements including information for linking to information about a corresponding product;
- “...means for recording whether the respective publisher has authorized display of the printed item;

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- ...searching for web pages, the search being based on the search query...thereby identifying Internet web pages and relevant data sets corresponding to relevant publication items;
- means for returning at least one characterization of at least of the relevant web pages and at least one characterization of at least one of the relevant publication items and, for said at least one of the relevant publication items for which the respective publisher has authorized to display, providing an electronic path for accessing a copyrighted version thereof,
- wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items."

With respect to Claim 43, an analogous art, Smith, teaches:

- "...the advertisements including information for linking to information about a corresponding product" [Smith, cols. 2-3, lines 59-5].

With respect to Claim 43, an analogous art, Baxter, teaches:

- "... means for recording whether the respective publisher has authorized display of the printed item [Baxter, paragraphs [0037], [0041], [0141] and [0145]]
- ...and for said at least one of the relevant publication items for which the respective publisher has authorized to display, [Baxter, paragraphs [0037], [0041], [0141] and [0145]].

With respect to Claim 43, an analogous art, Mitchell, teaches:

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- "...searching for web pages, the search being based on the search query [Mitchell, col. 9, lines 24-30 with Mitchell, cols. 13-14, lines 64-7] thereby identifying Internet web pages and relevant data sets corresponding to relevant publication items; [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21 with Mitchell, col. 9, lines 8-30]
- means for returning at least one characterization of at least of the relevant web pages and at least one characterization of at least one of the relevant publication items [Mitchell, col. 7, lines 43-46 with Mitchell, cols. 13-14, lines 64-7 with Mitchell, Fig. 11 with Mao, col. 7, lines 12-21]... providing an electronic path for accessing a copyrighted version thereof [Mitchell, col. 9, lines 14-16 with Mitchell, col. 9, lines 30-32]
- wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items" [Mitchell, Fig. 11 with Mitchell, col. 9, lines 8-32].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell, Baxter and Smith with Mao because the inventions are directed towards searching for documents.

Mitchell, Baxter and Smith's inventions would have been expected to successfully work well with Mao's invention because the inventions use databases. Mao discloses a method an apparatus for indexing and searching content in hardcopy

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documents comprising scanning whole documents, OCRing them, and indexing them, however Mao does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, publisher authorization, or ads with information for linking. Mitchell discloses an automated capturing of technical documents for electronic review and distribution comprising converting hardcopy technical documents in to web pages, indexing and searching the HTML web pages, and displaying results of searches against the documents. Baxter discloses a method and apparatus for safeguarding files comprising a way to determine if they should be displayed. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the characterizations and web pages of printed matter from Mitchell, the determination if information should be displayed from Baxter, and the database of ads with their associated information from Smith and install them into the invention of Mao, thereby offering the obvious advantage of retrieving more relevant results to a query, control the access to documents to safeguard them from non-authorized people, finding web pages associated with the documents found, accessing them, and storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

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21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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### Conclusion


22. Any prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is advised that, although not used in the rejections above, prior art cited on any PTO-892 form and not relied upon is considered materially relevant to the applicant's claimed invention and/or portions of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent S. Stace whose telephone number is 571-272-8372 and fax number is 571-273-8372. The examiner can normally be reached on M-F 9am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu M. Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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